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EXAMINER

PONOMARENKO, NICHOLAS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD G. CARPENTER

Appeal 2007-3573
Application 09/935,936¹
Technology Center 2800

Decided: August 5, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and MARC S.
HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a non-final rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention relates to method and apparatus for converting mechanical energy into electrical energy (Spec. 1). Two pistons move in a reciprocating, synchronous manner, driven by respective piston rods with speeds that are a sinusoidal function of their separation from each other

¹ Application filed August 23, 2001.

(Spec. 22). Each of the facing surfaces of the two pistons has four circular openings, disposed directly opposite one another. Magnetized objects are to be ejected at high speed from one piston to the other repeatedly (Spec. 22-23). Kinetic energy is to be extracted from the received magnetized objects and converted into electrical energy (Spec. 24).

Claim 1 is exemplary:

1. A device for converting kinetic energy into electrical energy comprising, a first moving system, a second moving system for relative movement toward and away from said first moving system, an object for transfer between said first moving system and said second moving system for developing the kinetic energy relative thereto, means for converting the kinetic energy from said object at second moving system into electrical energy

The Examiner does not rely upon prior art in rejecting the claims under appeal.

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-8 stand rejected under 35 U.S.C. § 101 as not being supported by either a known asserted utility or a well-established utility.

Appellant contends that the principle of conservation of energy is not valid, or at least is not universally true (App. Br. 14), and provides a declaration from the inventor which includes a description of an experiment that purports to demonstrate the operability of Appellant's invention.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the (Fourth Supplemental) Brief (filed November 14, 2005), the Examiner's Answer (mailed July 3, 2006), and the Reply Brief (filed August 28, 2006) for their respective details.

ISSUES

The two principal issues in the appeal before us, closely related to one another, are whether the Examiner erred in finding that the Specification does not enable one of ordinary skill in the art to make and use the invention without undue experimentation, and whether the Examiner erred in holding Appellant's invention to be inoperative because it contradicts known scientific principles.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellant, he has invented a method and apparatus for converting mechanical energy into electrical energy (Spec. 1). Two pistons move in a reciprocating, synchronous manner, driven by respective piston rods with speeds that are a sinusoidal function of their separation from each other (Spec. 22). Each of the facing surfaces of the two pistons has four circular openings, disposed directly opposite one another. Magnetized objects are to be ejected at high speed from one piston to the other repeatedly (Spec. 22-23). Kinetic energy is to be extracted from the received magnetized objects and converted into electrical energy (Spec. 24).

PRINCIPLES OF LAW

The standard for determining whether the Specification meets the enablement requirement is whether a person skilled in the art can make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). If the examiner's basis for questioning the

sufficiency of the disclosure is reasonable the burden shifts to appellants to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 1392 (CCPA 1973).

An invention that is “inoperative” (i.e., it does not operate to produce the results claimed by the patent applicant) is not a “useful” invention in the meaning of the patent law. *See, e.g., Newman v. Quigg*, 877 F.2d 1575, 1581 (Fed. Cir. 1989). A disclosure of a utility satisfies the utility requirement of Section 101 unless there are reasons for the artisan to question the truth of such disclosure. *In re Gaubert*, 524 F.2d 1222, 1224 (CCPA 1975); *In re Langer*, 503 F.2d 1380, 1391-92 (CCPA 1974).

When a patent applicant presents an application describing an invention that contradicts known scientific principles, the burden is on the Examiner simply to point out this fact to Appellant The burden shifts to Appellant to demonstrate either that his invention, as claimed, does not violate basic scientific principles or that those basic scientific principles are incorrect. *Newman v. Quigg*, 681 F. Supp. 16, 18 (D.D.C. 1988).

ANALYSIS

Enablement and utility

We will address the rejections of the claims under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 101 together. The lack of utility because of inoperativeness (a question of fact), and the absence of enablement (a question of law), are closely related grounds of unpatentability. *Ex parte Dash*, 27 USPQ2d 1481, 1484 (Bd. Pat. App. & Int. 1992).

The Examiner rejected claims 1-8 as lacking enablement under § 112, and as inoperative under § 101, because the invention contradicts the principle of conservation of energy, and because the Specification does not explain how to make and use the claimed “means for converting kinetic energy... into electrical energy” (Ans. 5; Non-Final Rejection mailed September 15, 2004, at 6). We agree with the Examiner that claim 1 invokes 35 U.S.C. § 112, sixth paragraph, by reciting “means for converting the kinetic energy from said object at second moving system into electrical energy” (Ans. 5). The corresponding structure in the Specification purportedly produces more energy than it consumes (Appellant’s so-called “excess-energy” ΔE , Spec. 28), giving rise to the Examiner’s rejection.

From the beginning of prosecution, the Examiner has required Appellant to submit a working model (*see* Non-Final Rejection mailed November 7, 2002; Final Rejection mailed July 24, 2003; Non-Final Rejection mailed September 15, 2004; and the Examiner’s Answer).

Under the rule expressed in *Newman*, 681 F. Supp. at 18, the Examiner established a reasonable basis for questioning the sufficiency of the disclosure, and shifted the burden of proof to Appellant to come forward with evidence to support his claim that his device generates more energy than it consumes (Spec. 28). Despite the Examiner’s requirements, Appellant has never supplied the Office with a working model. Appellant’s efforts to carry his burden of proof consist of (a) argument that the principle of conservation of energy is not valid, or at least is not universally true (App. Br. 14), and (b) a declaration under 37 CFR § 1.132 from the inventor,

which includes a description of an experiment that purports to demonstrate the operability of Appellant's invention.

The cited textbook section (Peebles, *Principles of Physical Cosmology*) falls far short of establishing the falsity of the principle of conservation of energy. Prof. Peebles can only establish that "energy conservation is a good local concept" but that "there is not a *general global* energy conservation law in general relativity theory" (Peebles 139, emphasis added). We note that Prof. Peebles writes that "in a closed universe energy decreases as $1/a(t)$ as the universe expands," and ponders, "Where does the lost energy go?" (*Id.*) In the context of the energy of the universe as a whole, we have ample reason to conclude that Appellant's invention qualifies as "local" for the purposes of applying the principle of conservation of energy. We do not find Peebles persuasive to refute the Examiner's contention that the invention contradicts established scientific principles.

Appellant's Declaration under 37 C.F.R. § 1.132 (originally filed March 7, 2003; hereinafter, "Declaration") is not considered persuasive because the experiment described is not commensurate in scope with Appellant's claims. Appellant's experimental apparatus consists of a wooden bar suspended at each end (Declaration 2). Hanging by stranded picture wires from the wooden bar are identical metal hex-head screws, which engage endwise and compress a spring mounted between them when at the end of their respective swings (*Id.*). The screws are each swung back from the other and released, depositing their kinetic energy into the spring (*Id.*). The compression of the spring under various conditions is measured (*Id.*). From the amount of compression measured, Appellant computes from

theory, *rather than measuring directly*, the “differential Energy or work,” and concludes that extra energy has been produced from “some source” not identified (Declaration 4).

We observe, however, that no means for converting kinetic energy from the object in the “second moving system” into electrical energy, as is required by the claims, is present in the experimental apparatus. Without the presence of such energy conversion means in the experiment, we cannot find the experimental results persuasive of the operability of the claimed invention.

Because Appellant has not satisfied his burden of proving that one of ordinary skill can make and use the claimed invention without undue experimentation, or that his invention is not inoperable, we do not find error in the Examiner’s rejections of claim 1, nor in that of claims 2-8 not separately argued, under 35 U.S.C. §§ 101 and 112.

CONCLUSION OF LAW

We conclude that Appellant have not shown that the Examiner erred in rejecting claims 1-8. Claims 1-8 are not patentable.

DECISION

The Examiner’s rejection of claims 1-8 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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gvw

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